

REMARKS

Summary of the Office Action

Claims 1, 2 and 4 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,969,680 to *Tsuru et al.* (“*Tsuru*”).

Claim 3 stands rejected under 35 U.S.C. §103(a) as being unpatentable over *Tsuru* in view of U.S. Patent No. 6,100,849 to *Tsubaki*.

Summary of the Response to the Office Action

Applicants respectfully submit that the features of the present invention are not taught or suggested by the references of record. New claims 5-7 are added to provide an alternative scope of protection. Accordingly, claims 1-7 are pending for further consideration.

All Subject Matter Complies with 35 U.S.C. § 102(b)

Claims 1, 2 and 4 stand rejected under 35 U.S.C. §102(b) as being anticipated by *Tsuru*. Applicants respectfully traverse the rejection for the following reasons.

Applicants respectfully submit that the Office Action has not established that *Tsuru* anticipates each and every feature of Applicants’ claimed invention and that all rejections under 35 U.S.C. § 102(b) should be withdrawn. Namely, Applicants contend that independent claim 1 recites the feature of “a radiation electrode, having a first end which is left open and a second end which is connected to the ground electrode . . . a feeding electrode, having a first end which is connected to and directly contacts the feeding terminal and a second end which is connected to and directly contacts the ground electrode, at least a first part of the feeding electrode being extended in parallel with an elongated direction of the radiation electrode, so as to excite the

radiation electrode with an induction coupling in a non-contact manner.” At least these features are not disclosed or taught by *Tsuru*.

Tsuru discloses a surface mounted type antenna with a power supplying portion (13, 35, 52) and a radiation portion (5, 27, 56a) in lieu of an inverted F-type antenna. See Figs. 4, 5, and 9A and col. 5, lines 8-67 of *Tsuru*. However, the structure of *Tsuru* fails to teach or suggest at least the above features of claim 1.

The Office Action asserts that *Tsuru* discloses the elements of claim 1 “all arranged as claimed.” Contrary to this assertion, *Tsuru* discloses a surface mounted antenna with a radiation portion *capacitively* connected to the ground electrode. The Office Action suggests the term *capacitively* could be inferred to modify the term “connected” in claim 1. However, the Office Action ignores the conventional meaning of the term connected and claim 1 itself, which recites that the radiation electrode is simply “connected” to ground electrode and not *capacitively* connected to it. Claim 1 of the present invention, however, recites both connections and couplings. Connections concern the ends of terminals or electrodes that are physically “connected” to each other. Couplings concern parallel surfaces that are not in contact with each other and create “an induction coupling in a non-contact manner.” Thus, the assertion in the Office Action that the radiation portion may be *capacitively* connected to the ground electrode is erroneous because any such arrangement would be recited as a non-contact coupling instead. In other words, if the connection between the radiation electrode and the ground electrode were intended to be *capacitively* connected as suggested in the Office Action, then it would have been recited as a non-contact coupling. Applicants respectfully submit that because *Tsuru* does not disclose “a radiation electrode, having a first end which is left open and a second end which is

connected to the ground electrode,” it cannot anticipate the invention recited in claim 1.

Further, claim 1 also recites “a feeding electrode having a first end which is connected to and directly contacts the feeding terminal and a second end which is connected to and directly contacts the ground electrode, at least a first part of the feeding electrode being extended in parallel with an elongated direction of the radiation electrode, so as to excite the radiation electrode with an induction coupling in a non-contact manner.” At least these features are not disclosed or taught by *Tsuru*.

The Office Action states that *Tsuru* discloses “a feeding terminal 66 provided on the first surface (Fig. 2) and a feeding electrode 52 having a first end 67b connected to and directly contacts the feeding terminal and a second end 52e which is connected to and directly contacts ground electrode 67a, at least a first part 52a of the feeding electrode 52 extending in parallel with an elongated direction of the radiation electrode 56a, so as to excite the radiation electrode with an induction coupling.” However, the Office Action is in error. If 52 is the feeding electrode, how can 67b be its first end when 67b is not the same component and is actually the ground electrode? See Fig. 2 and col. 8, line 44 through col. 9, line 34 of *Tsuru*. Further, 52 is the power supplying portion or the device shown in Fig. 2 not just the feeding electrode.

Another error in the Office Action occurs with regard to the feeding electrode 52. If the first end is presumably 52d and the second end is 52e for the feeding electrode, then any “first part” must occur between these two ends of the feeding electrode 52. To the contrary, the so-called first part 52a is not located between the first end 52d and the second end 52e of the feeding electrode.

As pointed out in MPEP § 2131, a claim is anticipated by a prior art reference only if each and every element as set forth in the claim is found. *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051 (Fed. Cir. 1987). Therefore, Applicants respectfully assert that the rejection under 35 U.S.C. § 102(b) should be withdrawn because *Tsuru* does not teach or suggest each feature of independent claim 1.

Additionally, Applicants respectfully submit that dependent claims 2 and 4 are also allowable insofar as they recite the patentable combinations of features recited in claim 1, as well as reciting additional features that further distinguish over the applied prior art.

All Subject Matter Complies with 35 U.S.C. § 103(a)

Claim 3 stands rejected under 35 U.S.C. §103(a) as being unpatentable over *Tsuru* in view of *Tsubaki*. Applicants respectfully traverse the rejection for the following reasons.

To establish a *prima facie* case of obviousness, three basic criteria must be met (see MPEP §§ 2142-2143). First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill the art, to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the prior art references must teach or suggest all the claim limitations. All three criteria must be met to establish obviousness.

Applicants respectfully submit that *Tsubaki* does not make up for the deficiencies identified in *Tsuru*. *Tsubaki* is relied upon for teaching “an electrical length of the first part of the feeding electrode is substantially equal to one fourth of a wavelength at an operation frequency of the antenna,” but it does not identify where in columns 6 and 7 of *Tsubaki* these features are taught. Thus, *Tsubaki* cannot teach or suggest all the features of the present

invention. As such, Applicants respectfully assert that the third prong of *prima facie* obviousness has not been met.

As pointed out in M.P.E.P. § 2143.03, “[t]o establish prima facie obviousness of a claimed invention, all the claimed limitations must be taught or suggested by the prior art”. *In re Royka*, 409 F.2d 981, 180 USPQ 580 (CCPA 1974). Therefore, Applicants respectfully assert that claim 1 is distinguishable over the applied art and the rejections under 35 U.S.C. § 103(a) should be withdrawn because neither *Tsuru* nor *Tsubaki* teaches or suggests each and every feature of claim 3.

CONCLUSION

In view of the foregoing, Applicants respectfully request reconsideration and the timely allowance of the pending claims. Should the Examiner feel that there are any issues outstanding after consideration of this response, the Examiner is invited to contact Applicants' undersigned representative to expedite prosecution.

If there are any other fees due in connection with the filing of this response, please charge the fees to our Deposit Account No. 50-0310. If a fee is required for an extension of time under 37 C.F.R. § 1.136 not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

Respectfully submitted,

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